

### **Remarks**

The Office Action mailed September 16, 2005 has been carefully reviewed and the following remarks are made in consequence thereof.

Claims 1-15 and 19-27 are now pending in this application, of which claims 1-13 and 19 have been amended. Claims 16-18 are cancelled herein and claims 20-27 are newly added. It is respectfully submitted that the pending claims define allowable subject matter.

In accordance with 37 C.F.R. 1.136(a), a one month extension of time is submitted herewith to extend the due date of the response to the Office Action dated September 16, 2005 for the above-identified patent application from December 16, 2005, through and including January 16, 2006. In accordance with 37 C.F.R. 1.17(a)(1), authorization to charge a deposit account in the amount of \$120.00 to cover this extension of time request also is submitted herewith.

The objection to the drawings is respectfully traversed.

The references to features "501" and "801" in the specification was in error and have now been corrected and deleted, respectively, from the specification.

The specification has also been amended for consistency with the drawings as filed with respect to Figures 4A-1 through 4D-1, and 4A-2 through 4D-2.

The amendment to the specification is believed to render the drawing rejection moot. Applicants accordingly request withdrawal of the objection to the drawings.

The objection to the disclosure is respectfully traversed. The specification has been amended to include brief descriptions of Figures 5A-5C, Figures 6A-6C, Figures 7A-7C, and Figures 8A-8C.

The rejection of Claims 1, 2, 4, 6 and 16-19 under 35 U.S.C. § 102(b) as being anticipated by White (U.S. Patent No. 2,759,577) is respectfully traversed.

Claim 1 has been amended for clarity and now recites a weight determining mechanism for a piece of luggage, the mechanism comprising “a carrying device designed to engage a part of a human body,” “at least one resistance mechanism having opposing first and second ends, wherein said resistance mechanism is altered by-an application of force on said resistance mechanism whenever the piece of luggage is lifted via the carrying device, said resistance mechanism being coupled to the piece of luggage at the first end and the second end so that the weight of said luggage provides said application of force,” and “at least one indicator viewable from an exterior of the grip and responsive to alteration of said resistance mechanism when the luggage is lifted via the carrying device, wherein said indicator provides an indication of the weight of the piece of luggage.”

White does not disclose or suggest the mechanism of claim 1. It is clear, for example, that the White weighing device is locked as a rigid structure in one mode wherein the bag may be carried from place to place without bringing into operation the mechanism of the weighing scale. When desired, the scale is usable by depressing a push button (50). The scale is therefore not is altered by-an application of force whenever the handle (11) is lifted as claim 1 recites, but rather the White scale experiences no lifting force unless and until the pushbutton (50) is depressed.

Additionally, the tension springs (29) and (30) of White are each coupled to the bag (10) at one end only via bolts (21) and (22). The opposing ends of the springs (29) and (30) are mounted to respective pins (27) and (28) in the legs (13) and (14) of the handle (11). White therefore neither describes nor suggests a resistance mechanism being coupled to the piece of luggage via first end and the second ends so that the weight of said luggage provides an application of force as claim 1 recites.

Claim 1 is therefore submitted to be patentable over White.

Claims 2, 4, and 6 depend from independent claim 1, and when the recitations of claims 2, 4, and 6 are considered in combination with the recitations of claim 1, claims 2, 4, and 6 are likewise submitted to be patentable over White.

Claims 16-18 are cancelled herein.

Claim 19 has also been amended for clarity and now recites, among other recitations, that weight is distributed across said means for determining solely by lifting said means for lifting. As noted above, this is distinguishable from the bag of White, which requires a pushbutton (50) to be depressed to release the scale from a locked position, allowing the bag to subsequently be weighed. It is respectfully submitted that, as a consequence of the pushbutton, the White scale is not operable solely by lifting of the handle, but rather requires actuation of the pushbutton prior to lifting of the handle. The pushbutton and locking/unlocking of the White scale, which is clearly a desirable feature as presented in the White disclosure, is submitted to actually teach away from the present invention. Claim 19 is therefore submitted to be patentable over White.

Applicants therefore respectfully request the rejection of claims 1, 2, 4, 6 and 16-19 be withdrawn.

The rejection of claims 7-10 under 35 U.S.C. § 103(a) as being unpatentable over White is respectfully traversed.

Claim 7-10 depend from claim 1, is submitted to be patentable over White for the reasons set forth above. When the recitations of claims 7-10 are considered in combination with the recitations of claim 1, claims 7-10 are likewise submitted to be patentable over White.

Applicants therefore respectfully request the rejection of claims 7-10 be withdrawn.

The rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Wright (U.S. Patent No. 4,223,819) is respectfully traversed.

Claim 3 depends from claim 1, is submitted to be patentable over White for the reasons set forth above. Wright adds nothing to the teaching of White with respect to the invention of claim 1, and in fact does not disclose a weighing mechanism at all. Claim 1 is therefore submitted to be patentable over White in view of Wright, and when the recitations of claim 3 are considered in combination with the recitations of claim 1, claim 3 is likewise submitted to be patentable over White in view of Wright.

Applicants therefore respectfully request the rejection of claim 3 be withdrawn.

The rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over White in view of Takahashi (U.S. Patent No. 5,581,901) is respectfully traversed.

Claim 5 depends from claim 1, is submitted to be patentable over White for the reasons set forth above. Takahashi adds nothing to the teaching of White with respect to the invention of claim 1, and in fact does not disclose a weighing mechanism at all. Claim 1 is therefore submitted to be patentable over White in view of Takahashi, and when the recitations of claim 5 are considered in combination with the recitations of claim 1, claim 5 is likewise submitted to be patentable over White in view of Takahashi.

Applicants therefore respectfully request the rejection of claim 5 be withdrawn.

The rejection of claims 1 and 6-15 under 35 U.S.C. § 103(a) as being unpatentable over Marks (U.S. Patent No. 5,581,901) in view of White is respectfully traversed.

It is respectfully submitted that the present rejection is improper.

The Marks reference (WO 03/100360) was published December 4, 2003, which is after the filing date of December 16, 2002 corresponding to a U.S. provisional patent

application for the subject invention to which the present application claims priority. Applicants also note that international application of Marks was filed May 23, 2003, which is also after the filing date of December 16, 2002 to which the present application claims priority. Thus, Applicants respectfully submit that because the Marks reference was both filed and published prior to Applicants filing of the provisional application for the subject invention on December 16, 2002, the Marks reference does not qualify as prior art under any subsection of 35 U.S.C. § 102, and in particular the Marks reference does not qualify as prior art under 35 U.S.C. § 102(e) because the Marks PCT application was not filed "before the invention by the applicant for patent" as § 102(e) requires.

It is therefore respectfully submitted that Marks is not prior art vis-à-vis the present invention that may be properly cited to reject the present claims. Thus, because Marks is not prior art per the applicable provisions of 35 U.S.C. § 102, it may not be considered for evaluating the novelty of the present invention under 35 U.S.C. § 102 or for evaluating obviousness of the invention under 35 U.S.C. § 103. Applicants therefore respectfully request that the rejection of claims 1 and 6-15 based upon the Marks reference be reconsidered and withdrawn.

Applicants therefore respectfully request the rejection of claims 1 and 6-15 be withdrawn.

With respect to the newly added claims, claims 20-26 depend from independent claim 19, submitted to be patentable over the cited art for the reasons set forth above. When the recitations of claims 20-26 are considered in combination with the recitations of claim 19, claims 20-26 are likewise submitted to be patentable over the cited art.

With respect to newly added independent claim 27, Applicants submit that claim 27 is also distinguishable over the cited art. Claim 27 recites, among other recitations, "a generally flexible lifting element mounted to the luggage container portion and forming an integral part of the container portion." The handle of White is certainly not flexible,

but is rigid to permit locking of the scale and carrying of the bag without bring the scale into operation.

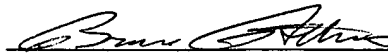
White also fails to disclose "a resistance element mechanically subjected to a load bearing weight of the container portion whenever the luggage container portion is lifted" as recited in claim 27, but rather discloses a bag including a locking mechanism that requires unlocking prior to operation of the scale, and hence the White scale only functions when the handle is lifted after the locking mechanism is released. The locking of the scale is an important feature of the bag as described by White, and the locking scale expressly precludes the invention of claim 27.

Wright and Takahashi are respectfully submitted to add nothing to the teaching of Takahashi with respect to the invention of claim 27, and for the reasons set forth above, Marks is not prior art that can be used to reject to claim 27.

Applicants therefore submit that claim 27 is patentable over the cited art.

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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